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| 09/823,566      | 03/30/2001  | Jay H. Connelly      | 42390P10859         | 6351             |

8791 7590 05/31/2005

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| EXAMINER |
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CHAMPAGNE, DONALD

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3622

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/823,566

Applicant(s)

CONNELLY, JAY H.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6-19-03 & 12-10-04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims 6, 12 and 18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims add only nonfunctional descriptive matter. See MPEP 2106.IV.B.1(b), first paragraph.

### *Claim Rejections - 35 USC § 102 and 35 USC § 103*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-9, 11-15, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Milnes et al. (US006118492A).
5. Milnes et al. teaches (independent claims 1, 7 and 13) a method, computer readable storage medium and apparatus, the method comprising: receiving content information (*TV schedule information*, col. 3 lines 6-7) in a data-stream compiled by *distribution center 10* (col. 2 lines 47-48); allocating line items (*channels*) in an EPG to one or more service providers, and merging the content information for display in the EPG (col. 3 lines 19-20 and 33-34); and

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charging each of the one or more service providers (*each broadcaster*) a predetermined amount for each allocated line item (*an additional fee per time slot*, col. 4 lines 36-39).

6. Milnes et al. does not explicitly teach that *distribution center 10* is a cached content service provider. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted the reference teaches that the *distribution center 10 compiles* data for the data-stream (col. 2 lines 47-48), which reads on collecting or caching data.
7. Interpretation of “cached content service provider” Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”.
8. The instant application contains no such clear definition for the phrase “cached content service provider”. The phrase is illustrated by several examples, but an example use does not meet the requirements for a “clear definition.” In the instant case, the examiner is required to give the term “cached content service provider” its broadest reasonable interpretation, which the examiner judges to be any provider of cached content (a service). The *distribution center 10* meets this definition (para. 6 above). Indeed, virtually any distributor of information must cache at some point, so any station or channel providing content reads on a cached content service provider.
9. Milnes et al. also teaches claims 2, 8 and 14 at the citations given above; claims 3, 9 and 15 (col. 2 lines 4-6 and col. 5 lines 1-7 with Fig. 4); and claims 5, 11 and 17 (col. 2 lines 44). Milnes et al. also teaches claims 6, 12 and 18 inherently because agreeing on an amount (*an additional fee*, col. 4 line 38) reads on negotiating a predetermined amount.

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10. Claims 4, 10 and 16 are rejected under 35 U.S.C. 103(a) as obvious over Milnes et al.

Milnes et al. does not teach assigning one line item to each of the cached content service providers. However, Milnes et al. does teach assigning a special link to classes of programming (programming *themes*, col. 7 lines 1-7 including Fig. 4). Because viewers can have special interests in each channel, which reads on a cached content service provider, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Milnes et al. that a special link/line item, such as that in Fig. 4, be assigned to each of the channels/cached content service providers.

### ***Conclusion***

11. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Swain et al. (US 20010047516A1) teaches some of the disclosed, but not claimed, features of the instant application.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
13. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
15. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue

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prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

21 May 2005